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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,272	09/30/2003	Andrew R. Ferlitsch	SLA1319	6569
50735 7590 07/15/2009 AUSTIN RAPP & HARDMAN 170 SOUTH MAIN STREET SUITE 735 SALT LAKE CITY, UT 84101				
EXAMINER				
BLAIR, DOUGLAS B				
ART UNIT		PAPER NUMBER		
2442				
MAIL DATE		DELIVERY MODE		
07/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,272

Applicant(s)

FERLITSCH, ANDREW R.

Examiner

DOUGLAS B. BLAIR

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 1, 9, and 17 have been amended. Claims 1-24 are pending.

Response to Arguments

Applicant's arguments filed 5/11/2009 have been fully considered but they are not persuasive.

The applicant first argues the following:

Because a user submitting print jobs to the printer would expect the printer drivers to already be installed on the workstation, the steps performed in Kemp are performed prior to the "creation of a print job." Thus, Kemp does not teach or suggest "determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device."

This argument however ignores the broad nature of the applicant's claim. In Kemp, the determination of the network address via the HTML pages could very well be in response to the user creating a print job that is "to be sent". This language is broad enough to cover the teachings of Kemp because it is not specific about how the print job is created nor is the claim specific to how the response is handled. Kemp clearly discusses print jobs being created throughout Kemp's disclosure. Kemp clearly states that the purpose of Kemp's invention is to make it easier to submit a print job to a printer (col. 1, lines 45-55).

The applicant then argues that Kemp does not teach or suggest the use or nonuse of API's for obtaining network addresses. The Examiner points out that page 4, line 20-page 5, line 9 and page 9, line 18-page 10, line 2 do not feature any disclosure that provides any explanation of novelty to the public. Instead this citations merely state that if a convention technique is not available then the claimed network address discovery technique is used. Kemp is directed

towards the same concept as illustrated in the previous rejection and the Examiner sees no patentable distinctions within the applicant's disclosure.

In summary, it is unclear to the Examiner what novel details the applicant is putting the public in possession of in exchange for the claimed protection sought and thus the Examiner cannot find the claims patentable over the prior art used to reject the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-11, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke.

As to claim 1, Kemp teaches a method for communicating between a client device and a peripheral device over a network that includes the peripheral device (Ref. numbers 40-42 in Figure 1), the client device (Ref. numbers 20 and 21), and a server device (Ref. number 51) adapted to control the peripheral device, the peripheral device having a network address which is not known to the client device, wherein the method is performed by the client device, the method comprising: determining a network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device (col. 1, lines 45-55), wherein the peripheral device has a network address that is not known to the client device, wherein the client device is

unable to use an existing API call to obtain the network address of the peripheral device (col. 6, lines 53-59) and, wherein the determining includes: retrieving a first data file from the server device, wherein the first data file is a web page (Figure 6); identifying one or more portions of the retrieved first data file as potential network addresses (Figure 6 shows network addresses); identifying one or more potential network addresses of the retrieved first data file as network addresses (Figure 6); and determining if a network address is the network address of the peripheral device (Figure 6); addressing the peripheral device using the determined network address of the peripheral device; and communicating directly with the peripheral device, thereby bypassing the server device (col. 2, lines 30-47); however Kemp does not explicitly teach the method including comparing the one or more potential network addresses of the retrieved first data file with predetermined data formatting pattern indicative of a network address.

Burke teaches a method of comparing one or more potential network addresses of a retrieved data file with a predetermined data formatting pattern indicative of a network address (col. 4, line 55-col. 5, line 7).

It would have been obvious to one of ordinary skill in the Computer networking art at the time of the invention to combine the teachings of Kemp regarding using a web page to find peripherals with the teachings of Burke regarding the recognition of address formats because the teachings of Burke are broad enough to apply to the application taught by Kemp (See Burke, col. 8, lines 35-46).

As to claims 2 and 3, these limitations are taught by the cited portion of Burke.

Claims 9-11 and 17-19 are rejected for the same reasons claims 1-3.

Claims 4-8, 12-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,213,060 to Kemp et al. in view of U.S. Patent Number 6,032,162 to Burke. in further view of U.S. Patent Application Publication Number 2002/0059489 by Davis et al.

As to claim 4, the Kemp-Burke combination teaches the method of claim 1; however the Kemp-Burke combination does not teach the redundancy of having a file with an address to another file.

Davis teaches an addressable data file containing a list of printers including their addresses (paragraph 31).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Kemp-Burke combination regarding the addressing of printers with the teachings of Davis regarding an addressable data file that contains printer addresses because a data file containing printer addresses allows for a central location for maintaining printer data.

As to claims 5-8, the Kemp-Burke combination makes obvious recognizing an address as discussed and testing as claimed in that once the user tries to use the address, the user will be "testing" it.

Claims 12-16 and 18-24 are rejected for the same reasons as claims 4-8.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Douglas B Blair/
Primary Examiner, Art Unit 2442